

### REMARKS

Claims 1-5, 7, 8, 12, 13, 16, 17, 22, 25, 26, 80-94, 96, 97, and 99-103 are pending.

Claims 1, 22, 80, 91, 102 and 103 have been amended. No new matter has been added.

### CLAIM REJECTIONS

#### *Rejection of claims under 35 U.S.C. §112, first paragraph*

The Examiner has maintained the rejection of claims 1-5, 7-8, 12-13, 16-17, 22, 25-26, 80-94, 96, 97, and 99-103 under 35 U.S.C. §112, first paragraph. See pages 2-4 of Office Action.

In an effort to expedite prosecution and not in acquiescence to the rejection, Applicants have amended claims 1, 22, 80, 91, 102-103 to include compounds in which the variable group  $Y^2$  is  $-\text{CH}_2-$  or a bond. See amended claims 1, 22, 80, 91, 102, 103. Applicants respectfully request reconsideration and withdrawal of this rejection with respect to independent claims 1, 22, 80, 91, 102 and 103 and dependent claims thereof.

Applicants disagree with the Examiner's arguments. Specifically, the Examiner contends that "the specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make or use the invention commensurate in scope with these claims." See page 2 of Office Action. The Examiner further contends that "the specification, while being enabling for making compounds in which the variable group  $Y^2$  is  $-\text{CH}_2-$  or a bond, does not reasonably provide enablement for making compounds in which the variable group  $Y^2$  is  $-\text{CH}_2-$  or a bond." See page 2 of Office Action. The Examiner alleges that "[c]ompounds in which  $Y^2$  connects to the group  $-\text{C}(\text{X}_1)\text{X}_2\text{H}$  via a heteroatom are known to be inherently unstable and will decompose, under normal conditions ...." See page 3 of Office Action.

With respect to the Examiner's arguments concerning the instability of compounds, Applicants note that the Examiner provides the Solomons reference as support for this contention and directs Applicants to page 798, lines 4-13 of Solomons. See page 4 of Office Action. The Examiner further states that "this instability form[s] the chemical basis for the well-known carbamate protecting groups such as t-BOC and FMOC." See page 4 of Office Action. Applicants respectfully submit that based on the Examiner's argument and interpretation, compounds such as carbonic acid and sodium bicarbonate would be inherently unstable and would not exist. The Examiner fails to take into account that stability of such compounds can

depend on conditions. As such, Applicants continue to maintain that compounds of formula (I) in which Y<sup>2</sup> is a heteroatom can be made and are stable, although the stability of the compounds can depend on conditions.

***Rejection of claims under 35 U.S.C. §102(b)***

The Examiner has rejected claims 80-84, 86-88, 90, 91-94, 96, 97, 99, 100, 101 and 103 under 35 U.S.C. §102(b) as being anticipated by Linderman et al., *Journal of Organic Chemistry*, 1999, 64, p. 336-337 ("Linderman"). See page 5 of Office Action. Claims 81-84, 86-88, 90 depend from independent claim 80. Claims 92-94, 96, 97, 99, 100, and 101 depend from independent claim 91. Claim 103 is an independent claim.

Linderman describes "the compound 11e, PhCH=CFCH<sub>2</sub>CH(NH<sub>3</sub>Cl)CO<sub>2</sub>H having the double bond in trans configuration in pharmaceutically acceptable solution in D<sub>2</sub>O (containing H<sub>2</sub>O). See page 5 of Office Action. The compound described in Linderman has a C<sub>4</sub> hydrocarbon chain and a fluoro substituent. Linderman does not describe the compound of formula (I) in claim 80 wherein L is a straight C<sub>5-12</sub> hydrocarbon chain. Further, for the compounds of formula (I) in claims 91 and 103, L does not include fluoro substituents. As such, the compound described in Linderman is not within the scope of claims 80, 91 and 103.

Accordingly, independent claims 80, 91, and 103 and claims that depend therefrom are not anticipated by Linderman for at least the reasons described above. Applicants respectfully request reconsideration and withdrawal of this rejection.

**CONCLUSION**

Applicants believe that the claims now pending are in condition for allowance. Should any fees be required by the present Amendment, the Director is hereby authorized to charge Deposit Account 19-4293.

Respectfully submitted,

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